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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,800	01/17/2006	Richard Farrar	1781-0017	5890
28078 7590 05/04/2007 MAGINOT, MOORE & BECK, LLP CHASE TOWER 111 MONUMENT CIRCLE SUITE 3250 INDIANAPOLIS, IN 46204			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 05/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,800	Applicant(s) FARRAR ET AL.	
	Examiner Nicholas Woodall	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/17/2005</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the guide block including connector shafts which extend from the fixation part to the guide part (claim 4), the drive including at least one threaded shaft on one of the fixation part or the guide part and a threaded bore on the other part (claim 10), the guide block further includes a flexible drive shaft which can be connected to the guide block (claim 13), and the guide block further including at least one position indicator (claim 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The examiner is unclear as to how a flexible drive shaft would be connected to the guide block and cause a relative rotation between the threaded shaft and the threaded bore. The examiner is going to interpret the claim to read, a guide block as claimed in claim 10, wherein the at least one drives includes a flexible shaft.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 10 recites the limitation "the drive" in line 1. There is insufficient antecedent basis for this limitation in the claim. The claim will be interpreted as ...at least one of the drives includes... for examination purposes.

7. Claim 11 recites the limitations "the shaft and the bore" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 12 recites the limitations "the shaft and the bore" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 13 recites the limitations "the shaft and the bore" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 3-9, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Milliard (U.S. Patent 6,712,824 B2).

Regarding claim 1, Milliard discloses a device comprising a fixation part that is capable of being directly fixed to tissue, a guide part having at least one structural feature capable of engaging a surgical tool, and at least two drives capable of adjusting the guide part relative to the fixation part in at least two degrees of freedom. Regarding claim 3, Milliard discloses a device wherein the fixation part of the guide block includes a housing that is hollow and in with the drives are located. Regarding claim 4, Milliard

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discloses a device further including connector shafts that extend from the fixation part to the guide part and move relative to the fixation part by respective ones of the drives to cause the location of the guide part to be adjusted. Regarding claim 5, Milliard discloses a device wherein the fixation part includes a means for adjusting the drives that are accessible from outside the housing. The applicant invokes 35 U.S.C. 112 6th paragraph in claim 5, which requires the examiner to reference the specification for structure that the applicant designates for performing the function of "adjusting the drives which are accessible from outside the housing". The applicant designates knobs, on page 3 of the specification, as being capable of performing the "means for" functional limitations of claim 5. Milliard discloses knobs being used for a similar function and therefore discloses the limitations of claim 5. Regarding claim 6, Milliard discloses a device wherein the guide part comprises a guide surface that is capable of being engaged by a blade. Regarding claim 7, Milliard discloses a device wherein the guide part comprises an opening that is capable of receiving a drill bit. Regarding claims 8 and 9, Milliard discloses a device wherein the guide block has a plurality of openings extending through capable of receiving a fastener. Regarding claim 14, Milliard discloses a device further including at least one position indicator fixed to the guide part and at least one position monitor that are capable of tracking the position of the guide part relative to a reference point.

12. Claims 1, 2, 4-6, 8-11, and 13 are rejected as understood under 35 U.S.C. 102(b) as being anticipated by Pohl (U.S. Patent 4,703,751).

Regarding claim 1, Pohl discloses a device comprising a fixation part that is capable of being directly fixed to tissue, a guide part having at least one structural feature capable of engaging a surgical tool, and at least two drives capable of adjusting the guide part relative to the fixation part in at least two degrees of freedom. Regarding claim 2, Pohl discloses a device comprising at least drives for adjusting the position of the guide part relative to the fixation part. Regarding claim 4, Pohl discloses a device further including connector shafts that extend from the fixation part to the guide part and move relative to the fixation part by respective ones of the drives to cause the location of the guide part to be adjusted. Regarding claim 5, Pohl discloses a device wherein the fixation part includes a means for adjusting the drives that are accessible from outside the housing. The applicant invokes 35 U.S.C. 112 6th paragraph in claim 5, which requires the examiner to reference the specification for structure that the applicant designates for performing the function of "adjusting the drives which are accessible from outside the housing". The applicant designates knobs, on page 3 of the specification, as being capable of performing the "means for" functional limitations of claim 5. Pohl discloses knobs being used for a similar function and therefore discloses the limitations of claim 5. Regarding claim 6, Pohl discloses a device wherein the guide part comprises a guide surface that is capable of being engaged by a blade. Regarding claims 8 and 9, Pohl discloses a device wherein the guide block has a plurality of openings extending through capable of receiving a fastener. Regarding claim 10, Pohl discloses a device in which at least one of the drives includes a threaded shaft on one of the fixation part and the guide part, and a threaded bore in the other of the fixation part and the guide part in

which the threaded shaft can be received by the thread bore and the guide part can be adjusted relative to the fixation part by rotating the threaded shaft relative to the threaded bore. The examiner is interpreting the reference wherein the screw (86) extends through the slot (66) and into a threaded bore (68). By rotating the screw (86), the surgeon is capable of loosening the guide part from the fixation part, so the guide part maybe rotated relative to the fixation part. Once the guide part has been positioned the surgeon can then tighten the screw (86) into the threaded bore (68). Regarding claim 11, Pohl discloses a device wherein at least one of the drives include a knob to cause rotation between the treaded shaft and the threaded bore. Regarding claim 13, Pohl discloses a device wherein at least one of the drives includes a flexible shaft. The examiner is interpreting flexible to mean any degree of flexibility, and all the shafts of the drives are capable of being flexed.

13. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Lackey (U.S. Patent 5,108,396).

Regarding claim 1, Lackey discloses a device comprising a fixation part that is capable of being directly fixed to tissue, a guide part having at least one structural feature capable of engaging a surgical tool, and at least two drives capable of adjusting the guide part relative to the fixation part in at least two degrees of freedom. Regarding claim 2, Lackey discloses a device comprising at least drives for adjusting the position of the guide part relative to the fixation part. Regarding claim 4, Lackey discloses a device further including connector shafts that extend from the fixation part to the guide part and move relative to the fixation part by respective ones of the drives to cause the

location of the guide part to be adjusted. Regarding claim 5, Lackey discloses a device wherein the fixation part includes a means for adjusting the drives that are accessible from outside the housing. The applicant invokes 35 U.S.C. 112 6th paragraph in claim 5, which requires the examiner to reference the specification for structure that the applicant designates for performing the function of "adjusting the drives which are accessible from outside the housing". The applicant designates knobs, on page 3 of the specification, as being capable of performing the "means for" functional limitations of claim 5. Lackey discloses knobs being used for a similar function and therefore discloses the limitations of claim 5. Regarding claim 6, Lackey discloses a device wherein the guide part comprises a guide surface that is capable of being engaged by a blade. Regarding claim 7, Lackey discloses a device wherein the guide part comprises an opening that is capable of receiving a drill bit. Regarding claim 8, Lackey discloses a device wherein the guide block has an opening extending through capable of receiving a fastener.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Milliard (U.S. Patent 6,712,824 B2) in view of Couture (U.S. Publication 2004/0039396).

Regarding claim 15, Milliard discloses the invention as claimed except for the device further including a computer assisted surgical system. Couture teaches a device further including a computer assisted surgical system in order to provide means for determining the position, orientation, and movement of the device in three-dimensional space (page 3 paragraph 036). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Milliard to further include a computer assisted surgical system in view of Couture in order to provide means for determining the position, orientation, and movement of the device in three-dimensional space.

Allowable Subject Matter

16. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



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SUPERVISORY PATENT EXAMINER